

PATENT CASE IN06009US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Bandarpalle B. Shankar, et al.

Serial No.: **10/803,577**

Filed: **03/18/2004**

For: **Cannabinoid Receptor Ligands**

Examiner: **To Be Assigned**

Group Art Unit: **1625**

Date: **February 24, 2005**

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to Rule 56, it is requested that the documents listed on the accompanying PTO-1449 Form be considered and made of record in the above-identified patent application. Copy(ies) of these references ☒ are attached ☐ were filed in related application U.S. Serial No(s) _____ filed _____, respectively.

(b) No fee is believed due because:

- ☐ This Information Disclosure Statement is being filed within three (3) months of the filing date of the application.
- ☐ This Information Disclosure Statement is being concurrently filed with the above-identified application.
- ☐ This Information Disclosure Statement is being concurrently filed with a Request for Continued Examination (RCE).
- ☒ This Information Disclosure Statement is being filed prior to the mailing of a first Office Action on the merits.

(c) ☐ This Information Disclosure Statement is being filed before the mailing date of any final action, notice of allowance or an action that otherwise closes prosecution; and

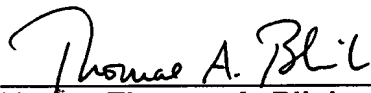
- ☐ Each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement; or
- ☐ No item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement; or

- ☐ The Commissioner is hereby authorized to charge the requisite fee listed on the attached Fee Transmittal Sheet.
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- ☐ The Commissioner is hereby authorized to charge the requisite fee listed on the attached Fee Transmittal Sheet.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 19-0365, Patent Case No. IN06009US01. DUPLICATE COPY OF THIS SHEET IS ATTACHED

Respectfully submitted,
SCHERING-PLOUGH CORPORATION

Dated: **February 24, 2005**
SCHERING-PLOUGH CORPORATION
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EV5391417US Box 1 of 2 ("AA" through "BS")

PTO/SB/21 (02-04)

Approved for use through 07/31/2006. OMB 0651-0031
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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/803,577
Filing Date	03/18/2004
First Named Inventor	Bandarpalle B. Shankar et al.
Art Unit	1625
Examiner Name	To Be Assigned
Attorney Docket Number	IN06009US01

Total Number of Pages in This Submission

8

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): PTO-1449 Form - 3 Pages; (66) References - Post Card
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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Thomas A. Blinka, Reg. No. 44, 541
Signature	<i>Thomas A. Blinka</i>
Date	02/24/2005

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

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FORM PTO-1449	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY. DOCKET NO.: IN06009US01	SERIAL NO.: 10/803,577
INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use several sheets if necessary)</i>		APPLICANT: BANDARPALLE B. SHANKAR et al.	
		FILING DATE: 03/18/2004	GROUP: 1625

U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE IF APPROPRIATE
	AB	4466965	08/21/84	Stout et al.			
	AB	4567184	01/28/86	Musser et al.			
	AC	5532237	07/02/96	Gallant et al.			
	AD	5332820	07/26/94	Duncia et al.			
	AE	5338753	08/16/94	Burstein et al.			
	AF	5462960	10/31/95	Barth et al.			
	AG	5486525	01/23/96	Summers, Jr. et al.			
	AH	5532237	07/02/96	Gallant Michel et al.			
	AI	5747524	05/05/98	Cullinan et al.			
	AJ	5925768	07/20/99	Barth et al.			
	AK	5948777	09/07/99	Bender et al.			
	AL	5990170	11/23/99	Della Valle et al.			
	AM	6100259	08/08/00	Elliott John Duncan et al.			
	AN	6013648	01/11/00	Rinaldi et al.			
	AO	6017919	01/25/00	Inaba et al.			

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION	
							YES	NO
	AP	DE19533644	09/12/95	GERMANY				
	AQ	EP0181568	05/21/86	EPO				
	AR	EP0401030	12/05/90	EPO				
	AS	EP0407217	01/09/91	EPO				
	AT	EP0885889	12/23/98	EPO				
	AU	EP1031571	08/30/00	EPO				
	AV	EP1283039	02/12/03	EPO				
	AW	FR2839718	11/21/03	FRANCE				
	AX	JP06072979	03/15/94	JAPAN				
	AY	WO 93/21158	10/28/93	PCT				
	AZ	WO 96/23783	08/08/96	PCT				
	BA	WO 97/03953	02/06/97	PCT				
	BB	WO 98/10763	03/19/98	PCT				
	BC	WO 98/31227	07/23/98	PCT				
	BD	WO 98/33769	08/06/98	PCT				
	BE	WO 98/41519	09/24/98	PCT				
	BF	WO 99/26612	06/03/99	PCT				
	BG	WO 99/36393	07/22/99	PCT				
	BH	WO 99/50245	10/07/99	PCT				
	BI	WO 00/06146	02/10/00	PCT				
	BJ	WO 01/28557 A1	04/26/01	PCT				
	BK	WO 01/29007	04/26/01	PCT				
	BL	WO 01 32169	05/10/01	PCT				
	BM	WO 01/37826	05/31/01	PCT				
	BN	WO 01/44172	06/21/01	PCT				
	BO	WO 01/44239	06/21/01	PCT				
	BP	WO 01/64642	09/07/01	PCT				
	BQ	WO 01/70753	09/27/01	PCT				
	BR	WO 01/74762	10/11/01	PCT				
	BS	WO 01/83460	11/08/01	PCT				

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FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION YES NO
	BT	WO 02/42248	05/30/02	PCT			
	BU	WO 02/060447	08/08/02	PCT			
	BV	WO 02/062750	08/15/02	PCT			
	BW	WO 03/020217	03/13/03	PCT			
	BX	WO 03/042174	05/22/03	PCT			
	BY	WO 2004/017920	03/04/04	PCT			
	BZ	WO 2004/018433	03/04/04	PCT			
	CA	WO 2004/029026	04/08/04	PCT			
	CB	WO 2004/029027	04/08/04	PCT			
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	CC	M. Curtin <i>et al.</i> , "Discovery and Evaluation of a Series of 3-Acylindole Imidazopyridine Platelet-Activating Factor Antagonists", 41(I) <i>J. Med. Chem.</i> 74-95 (1998)					
	CD	G. Hartman <i>et al.</i> , "4-Substituted Thiophene – and Furan – 2-sulfonamides as topical carbonic anhydrase inhibitors" 35(21) <i>J. Med. Chem.</i> 3822-31 (1992)					
	CE	G. Hartman <i>et al.</i> , "Synthesis and derivatization of 4-(arylsulfonyl) thiophene –and – furan – 2 sulfonamides", 27(2) <i>J. Heterocycl. Chem.</i> 127 – 34 (1990)					
	CF	P. Cozzi <i>et al.</i> , "New N-(2-ethoxyethyl)-N-(4-phenoxybenzyl) dichloroacetamides as potent antiamebic agents 18(3) <i>Eur. J. Med. Chem.</i> 203-208 (1983)					
	CG	U.S. Patent Application No. 10/214,897 (AL01381K1) for "Cannabinoid Receptor Ligands", filed August 5, 2003					
	CH	U.S. Patent Application No. 10/464,174 (AL01561K) for "Cannabinoid Receptor Agonists", filed June 17, 2003					
	CI	R.G. Pertwee, "Pharmacology of Cannabinoid Receptor Ligands", <i>Curr. Med. Chem</i> 6(8), (1999), 635 - 664					
	CJ	T.W. Greene <i>et al.</i> <i>Protective Groups in Organic Synthesis</i> (1981), Wiley, New York					
	CK	T. Higuchi and V. Stella, <i>Pro-drugs as Novel Drug Delivery Systems</i> (1975) 14 of the A.C.S. Symposium Series					
	CL	Bio reversible Carriers in Drug Design, (1987) Edward B. Roche, ed., American Pharmaceutical Association and Pergamon Press					
	CM	S. Berge <i>et al.</i> , "Pharmaceutical Salts", <i>Journal of Pharmaceutical Sciences</i> (1977) 66(1) 1-19					
	CN	P. Gould, "Salt Selection for Basic Drugs", <i>International J. of Pharmaceutics</i> (1986) 33 201-217					
	CO	Anderson <i>et al.</i> , <i>The Practice of Medicinal Chemistry</i> (1996), Academic Press, New York					
	CP	Copy of International Search Report for PCT/US 03/19245 (AL01561K) – 5 Pages					
	CQ	Copy of International Search Report for PCT/US 03/24398 dated 05/08/2003 for AL01381K1 – 6 Pages					
	CR	Copy of International Search Report for PCT/US2004/008333 dated 07/10/2004 for IN06009 12 Pages					
	CS	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294088 retrieved from Xfire Database accession no. 9568402, 9579279, 9582786, 9563319 Abstract & BIOORG, <i>Med. Chem.</i> Vol. 11, No. 18, 2003, Pages 3965-3974					

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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)					
	CT	Database Beilstein Beilstein Institute for Organic Chemistry, Frankfurt-Main, De; XP002294089 retrieved from XFIRE Database accession no. 8176641, 8176893 Abstract & MOL. PHARMACOL. Vol. 48, No. 2, 1995, Pages 352-361			
	CU	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294090 retrieved from XFIRE Database accession no. 8284677, 8286894, 8287610, 8289960, 8290344, 7780291, 7780333, 8288409, 7231571 Abstract & J. MED. CHEM. Vol 42, No. 4, 1999, Pages 769-776			
	CV	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294091 retrieved from XFIRE Database accession no. 8360417 Abstract & J. PHARMACOL, Vol. 126, 1999, Pages 665-672			
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	CX	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294093 retrieved from XFIRE Database accession no. 496619 Abstract & BIOORG. MED. CHEM. LETT Vol. 6 No. 19, 1996, Pages 2263-2268			
	CY	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294094 retrieved from XFIRE Database accession no. 2216071 Abstract & PHARMACOL. TOXICOL. Vol 80, 1997, Pages 103-107			
	CZ	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294095 retrieved from XFIRE Database accession no. 7226937 Abstract & BIOORG. MED. CHEM. LETT. Vol 6, No. 1, 1996, Pages 17-22			
	DA	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294096 retrieved from XFIRE Database accession no. 497341 Abstract & XENOBIOTICA, Vol. 24, No. 7, 1994, Pages 603-612.			
	DB	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294097 retrieved from XFIRE Database accession no. 7392775, 7389552, 7390283, 7392387 Abstract & J. MDE. CHEM. Vol. 41, No. 23, 1998, Pages 4521-4532			
	DC	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294098 retrieved from XFIRE Database accession no. 4302866 Abstract & J. PHARM. PHARMACOL. Vol. 53, No. 11, 2001, Pages 1525-1532			
	DD	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294099 retrieved from XFIRE Database accession no. 1610624 Abstract & CHEM. PHARM. BULL., Vol 42, No. 7, 1994, Pages 1459-1462			
	DE	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294100 retrieved from XFIRE Database accession no. 4604978 Abstract & J. HETEROCYCL. CHEM., Vol. 19, 1982, Pages 953-956			
	DF	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294101 retrieved from XFIRE Database accession no. 5466453 Abstract & PHARMAZIE, Vol. 47, No. 6, 1992, Pages 409-411			
	DG	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294102 retrieved from XFIRE Database accession no. 19404468 Abstract & AUST. J. CHEM Vol. 32, 1979, Pages 1531-1550			
	DH	Database Beilstein, Beilstein Institute for Organic Chemistry, Frankfurt – Main, De; XP002294142 retrieved from XFIRE Database accession no. 232835 Abstract & J. ORG. CHEM., Vol. 46, No. 20, 1981, Pages 4051-4057			
EXAMINER -			DATE CONSIDERED		
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